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IN THE

Supreme Court of the United States

OCTOBER TERM, [redacted] 1969

No. [redacted] 259

SVENSKA AEROPLAN AKTIEBOLAGET (SAAB),

Plaintiff-Petitioner,

—v.—

MERGENTHALER LINOTYPE COMPANY,

Defendant-Respondent.

PETITION FOR A WRIT OF CERTIORI
FILED BY PLAINTIFF-PETITIONER

BRIEF ON BEHALF OF DEFENDANT-RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI FILED BY PLAINTIFF-PETITIONER

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Jurisdiction

This is simply another run-of-the-mill patent infringement case and raises no questions which merit review or consideration by this Court. The Petition does not begin to measure up to the requirements of Rule 19.

Questions Presented for Review

The Petition poses three (unimportant and really immaterial) questions for review but all of them relate to the doctrine of equivalents. This is one of the oldest doctrines known to patent law and was enunciated by this Court as far back as 1897 in the *Westinghouse* case below. The doctrine is founded on the proposition that, to establish infringement, plaintiff must prove that the accused device and the patented device are substantially identical in structure, mode of operation and result,—not one but all three.

ARGUMENT

I.

Westinghouse v. *Boyden Power Brake Co.*, 170 U.S. 537, 18 S.Ct. 707

So far as we know, this decision has never been deviated from, either by this Court or by any of the other lower Courts. The doctrine is frequently invoked in patent infringement suits because it is seldom that an accused device is a Chinese copy of the patented device. The question which arises in such cases is really not so much a question of law but more a question of fact. In the instant case, both the Trial Court and the Appellate Court found as a fact that the Mergenthaler M-2 bombing instrument did not infringe the Saab patent for the reason that the claims of the Saab patent, in the light of the evidence and regardless of their scope, did not read on the M-2 instrument.

The prior art has nothing to do with the application of the doctrine of equivalents. In the *Westinghouse* case, the patent in suit represented a pioneer invention and there was no prior art which anticipated that invention. Nevertheless the Court held (p. 562) that the Westinghouse claims were much too broad and, hence, the fact "that the defendants' machine performs the same function is not conclusive that it is an infringement". This holding was made even though it appeared that the Westinghouse claims did read literally upon the accused device. In this connection the Court stated (p. 568):

> But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse claims, that does not settle conclusively the question of infringement. We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided (citations omitted). The converse is equally true. The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent.

II.

Graver Tank & Mfg. Co., Inc., et al. v. *The Linde Air Products Company*, 339 U.S. 605

In this case the Court on a rehearing was primarily concerned with the application of the doctrine of equivalents to extend a claim to cover that which is not literally within the claim, but the Court also took the opportunity to reaffirm the *Westinghouse* v. *Boyden* decision by explaining the doctrine of equivalents as follows (p. 608):

> The wholesome realism of this doctrine is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. Westinghouse v. Boyden Power Brake Co., 170 U.S. 537, 568.

III.

Halliburton Co. v. *Walker*, 329 U.S. 1, 12 (1946)

There is no conflict or inconsistency between this decision and the earlier *Westinghouse* decision. While the *Halliburton* decision rested on a finding of patent invalidity whereas the *Westinghouse* decision rested on a finding of non-infringement, the net result was the same in both cases, so far as the defendants were concerned.

The reason for the Court's decision in the *Halliburton* case is explained by the following observation made on page 12:

> Under these circumstances the broadness, ambiguity, and overhanging threat of the functional claim of Walker become apparent. What he claimed in the court below and what he claims here is that his patent bars anyone from using in an oil well any device heretofore or hereafter invented which combined with the Lehr and Wyatt machine performs the function of clearly and distinctly catching and recording echoes from tubing joints with regularity. Just how many different devices there are of various kinds and characters which would serve to emphasize these echoes, we do not know. The Halliburton device, alleged to infringe, employs an electric filter for this purpose. In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. See United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 236; Burr v. Duryee, 1 Wall. 531, 568; O'Reilly v. Morse, 15 How. 62, 112-13. Yet if Walker's blanket claims be valid, no device to clarify echo waves, now known or hereafter invented, whether the device be an actual equivalent of Walker's ingredient or not, could be used in a combination such as this, during the life of Walker's patent.

The final sentence in the foregoing quotation indicates that the Court did not ignore the doctrine of equivalents

or distinguish between claims "for a combination" and those of some other description. Actually the claims in both *Westinghouse* and *Halliburton* were so-called "combination" claims. In deciding to invalidate the Walker patent, this Court in the *Halliburton* case was evidently convinced that the claims in suit were so far out of line with and so repugnant to the patent statutes that they could not be sustained under any circumstances. The decision thus afforded full protection to the public as well as to the immediate defendant.

IV:

35 U.S.C. 112

There is likewise no conflict or inconsistency between this section and the earlier decisions of this Court discussed above. While the last paragraph of this section was added by the Patent Act of 1952, its language is clear and merely recites an old and well known principle of claim construction. It has been applied in many cases since the 1952 Act without creating any conflict of decisions. Its most frequent application is in Patent Office procedure which, before the 1952 Act, often required that the elements of a combination claim be expressed in terms of structure rather than in terms of function. But in passing on the question of infringement or the question of validity of a patent, the Courts do not distinguish, and do not need to distinguish, between claims of one type or another. The scope of the claims is what counts and controls.

V.

The Decision of the Court Below

This decision speaks for itself and needs no support. Plaintiff filed a Petition for Rehearing but that Petition was denied by the Court without comment.

It should perhaps be stated that the questions of law posed by the instant petition were not presented to the Court. As the Court said (pp. A-21, A-22):

> SAAB contends that the trial judge erroneously arrived at his holding of non-infringement by disregarding the claims of the patent in suit and their application to Mergenthaler's accused M-2 computer, and instead compared the M-2 with the illustrative computer disclosed in the specifications and drawings of the patent suit.

That was the whole basis of plaintiff's appeal and was completely demolished by the Court's opinion.

CONCLUSION

It is respectfully submitted that the plaintiff's petition is without merit and should be denied.

Respectfully submitted,

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July , 1969.